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09/137,503	08/20/1998	PETER A. GRAEF	WEYC111558	2949

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EXAMINER

RUHL, DENNIS WILLIAM

ART UNIT PAPER NUMBER

3761

DATE MAILED: 07/01/2003

25

Please find below and/or attached an Office communication concerning this application or proceeding.

N.K.

# Office Action Summary

Application No.

09/137,503

Applicant(s)

GRAEF ET AL.

Examiner

Dennis Ruhl

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1,6-23,26,31,32 and 75-77 is/are pending in the application.
- 4a) Of the above claim(s) 14,15,21-23,26 and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,6-13,16-20,32,75-77 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

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Applicant's amendment of 4/14/03 has been entered. The examiner will address applicant's remarks at the end of this office action.

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 16-18,77 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claims 16-18,77, what binder is being referred to here? Is this the binder of the 1<sup>st</sup> or 2<sup>nd</sup> stratum? Two distinct binders are claimed in claim 1. The examiner does not know whether or not the binder of the 1<sup>st</sup> stratum or the binder of the 2<sup>nd</sup> stratum is the recited structure of claims 16-18,77.

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

2. Claims 1,6,7,9-12,16,18,75-77, are rejected under 35 U.S.C. 103(a) as being unpatentable over Pieniak (4723954) in view of Graef et al. (5225047).

With respect to claims 1,6,7,75-77, Pieniak discloses a 1<sup>st</sup> stratum 32 and 2<sup>nd</sup> stratum 30. The 1<sup>st</sup> stratum has synthetic fibers (see col. 2, lines 57-60) and a binder (see column 3, lines 4-17). The 1<sup>st</sup> stratum is made from the claimed type of fiber (see polyester in column 2, lines 57-60). The 2<sup>nd</sup> stratum is made from wood pulp fibers and does have a binder. The term binder is being interpreted as it has been defined by the specification on page 13. The disclosure of air laying the 2<sup>nd</sup> stratum with compression or vacuum being applied acts to bind the layer together and is therefore considered a binder. This interpretation is commensurate with the definition provided by applicant in the specification on page 13. The fibers of each stratum are substantially commingled as claimed. See the figures, especially figure 2. Pieniak does not disclose that the fibers of the 2<sup>nd</sup> stratum are crosslinked cellulose fibers. Pieniak discloses the fibers of the 2<sup>nd</sup> stratum as being wood pulp. Graef discloses that crosslinked cellulose fibers provide advantages in absorbent articles such as being stiffer and tending to hold retained liquid better under compressive forces as compared to untreated fibers. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the 2<sup>nd</sup> stratum of Pieniak with crosslinked cellulose fibers as disclosed by Graef for the reasons set forth by Graef (i.e. being stiffer and tending to hold retained liquid better under compressive forces as compared to untreated fibers). With respect

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to claim 75, the limitation of "foam-formed" has been considered but is a product by process limitation and only the end structure of the article will be given patentable weight, not the manner in which the article was made. The resulting end structure is found in Pieniak.

With respect to claims 9,11, see column 2, lines 64-66, which satisfies the claimed range.

With respect to claims 10,12, Pieniak does not disclose what the density of the 2<sup>nd</sup> stratum is. The 2<sup>nd</sup> stratum of Pieniak does have a density, Pieniak is just silent as to what the value is. Optimization of the density through routine experimentation would have been obvious to one of ordinary skill in the art at the time the invention was made since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

With respect to claim 16, the binder of the 1<sup>st</sup> stratum is a fibrous binding material because it binds together fibers .

With respect to claims 18,77, Pieniak discloses one of the binders as being a wet strength agent. The binder disclosed for the 1<sup>st</sup> stratum in col. 3, lines 4-17 satisfy the claimed limitation.

3. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pieniak in view of Graef et al. and further in view of Anderson (4223677). Pieniak in view of Graef disclose the invention substantially as claimed. Not disclosed is that the pore size of the 1<sup>st</sup> stratum is greater than the pore size of the 2<sup>nd</sup> stratum. Anderson discloses an

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absorbent article that utilizes a pore size difference between layers of an absorbent to direct urine to the lower layer. Anderson discloses that a capillary gradient is created when the smaller pore sizes are in a lower layer and where the upper layer has a larger pore size. This drives the fluid to the lower layer as well as giving the lower layer more ability to hold onto the liquid already absorbed. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Pieniak with a 1<sup>st</sup> stratum with a larger pore size than the pore size of the 2<sup>nd</sup> stratum (as disclosed by Anderson) so that a capillary gradient is created for the reasons disclosed by Anderson.

### ***Double Patenting***

4. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claims 1,6-20,26, are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-23,25-32 of copending Application No. 09/620947 (a notice of allowance has been mailed in this application so a response on the merits to this rejection is required). This is a provisional double patenting rejection since the conflicting claims have not in fact been patented even though they have been indicated as being allowed by the USPTO.

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5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1,6-20,32,75-77 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the pending claims of copending Application No. 09/620953, 09/624263, 09/621167, 09/624262, 09/326213, 09/624081, 09/620947, 09/620950. Although the conflicting claims are not identical, they are not patentably distinct from each other because they overlap in scope and a terminal disclaimer is required to maintain common ownership of claims of overlapping scope. Some of the claims simply fail to recite elements of the claims of the above mentioned pending applications. *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

6. Applicant's arguments filed 10-15-02 have been fully considered but they are not persuasive.

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With respect to the argument about the binder, it is clear from a reading of the specification that the definition of binder is not solely limited to materials as is being argued by applicant. The definition says "Suitable binder can include but are not limited to...". This allows for the binder to be other than materials and in the binder paragraph it is stated that entanglement, needling, can be used. Needling and entanglement are not materials. Also from page 12, the definition set forth by applicant reads "As used herein the term binder refers to a system that is effective in mechanically intertwining or bonding the materials within .... This clearly does not limit the definition of binder to materials. The argument about the binder is non-persuasive. If applicant intends to recite a binder material why not amend the claim to recite that? The argument is not commensurate with the scope of the claims. The other arguments that state Pieniak and the secondary references used in the 103 do not suggest the claimed invention is more or less an argument that because the references are not 102 references, they cannot be used in a 103 rejection. Applicant has attacked the references of the 103 individually and has not addressed the combination set forth in the 35 USC 103 rejection. The arguments are non-persuasive.

With respect to the 101 provisional rejection and the provisional obviousness double patenting rejection, applicant has not traversed the rejections in any manner, so the examiner assumes the rejection to be valid.

3. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP



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§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Ruhl whose telephone number is 703-308-2262. The examiner can normally be reached on Tuesday through Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
**DENNIS RUHL**  
**PRIMARY EXAMINER**